



2838

## YANNY & SMITH

A LAW CORPORATION  
1925 CENTURY PARK EAST  
SUITE 1260  
LOS ANGELES, CALIFORNIA 90067  
PHONE: (310) 551-2966  
FAX: (310) 551-1949

JOSEPH A. YANNY, P.C. \*\*  
PATRICK K. SMITH †  
SEAN T. OSBORN  
MICHAEL A. DiNARDO †  
MICHAEL P. MARTIN  
REGINALD K. BROWN †

JULY 9, 2001

\* ALSO ADMITTED IN ILLINOIS  
† NOT ADMITTED IN CALIFORNIA/ADMITTED IN  
VIRGINIA  
\* REGISTERED PATENT ATTORNEY  
† OF COUNSEL

OUR FILE NO.: 3768  
RECEIVED  
JUL 17 2001  
TECHNICAL CENTER 2000

09/738024

### Via U.S. Mail

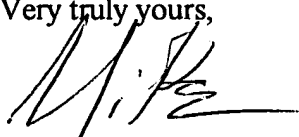
Mr. James H. Fritz  
SIMS LAW FIRM  
950 South Coast Drive, Suite 200  
Costa Mesa, CA 92626

**Re: Opposition to Petition to Inspect  
In re Application of Mullen, Nate**

Dear Mr. Fritz:

Enclosed is a copy of the opposition to your petition on behalf of Focus Lighting to inspect our client's patent application. This opposition was mailed to the patent office on Friday, July 6, 2001.

Very truly yours,

  
Michael A. DiNardo

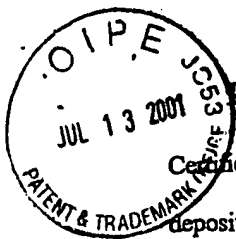
**RECEIVED**

AUG 03 2001

OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

encl.

cc: Via U.S. Mail  
The Honorable Director of Patents and Trademarks  
Washington, D.C. 20231



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Certificate of Mailing:

I hereby certify that this correspondence, and all the papers referenced herein, are being deposited with the United States Postal Services as first class mail in an envelope addressed to: The Honorable Director of Patents and Trademarks, Washington, D.C. 20231 on this date 7/16, 2001

Siobhan DiNardo  
Siobhan DiNardo

7/6 /01  
DATE

RECEIVED  
JUL 17 2001

TECHNOLOGY CENTER 2800

In re Patent Application of Nate Mullen.

Serial No.: [REDACTED]

For: [REDACTED]

Filed: December 14, 2000

Applicant: Nate Mullen

Our Docket: 3768

Grp Art Unit: 2838

Examiner:

RECEIVED

AUG 03 2001

The Honorable Director of Patents and Trademarks  
Washington, D.C. 20231

OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

REQUEST FOR DENIAL OF PETITION FOR ACCESS AND STATUS TO AN  
APPLICATION UNDER 37 C.F.R. 1.14(j).

Dear Sir:

Pursuant to 37 C.F.R. § 1.14(a), Applicant respectfully requests that the Director preserve in confidence patent application number 09/738,024 and deny the Petitioner and his designated attorney, James H. Fritz access to information concerning the filing, pendency, or subject matter of an application for patent, including status information and the application itself. The Applicant submits that the Petitioner has failed to show that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant the Petitioner being granted access to all or part of the application. Accordingly, the Applicant respectfully requests that the Petitioner's request be denied.

Section 122 of Title 35 United States Code mandates that patent applications are to be preserved in confidence absent special circumstances. 35 U.S.C. § 122(a). Pursuant to § 122, the Code of Federal Regulations provides "patent applications that have not been published under 35 U.S.C. § 122(b) are generally preserved in confidence pursuant to 35 U.S.C. § 122(a)." 37 C.F.R. § 1.14(a). In addition, § 1.14(a) provides "information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section." Id.

However, the Code allows a petitioner to gain access to a patent application under special circumstances. 37 C.F.R. § 1.14(j). Section 1.14(j) provides "the Office, either sua sponte or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances." 37 C.F.R. § 1.14(j). In addition, § 1.14(j) provides "any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include (1) the fee set forth in § 1.17(h); and (2) a showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application." Id.

The Director has determined that the use of a patent application by an applicant to interfere with the business of others may constitute special circumstances in order to warrant granting a petitioner access to the application. In re Crossman, Kenrick, and LeMieux, 187 U.S.P.Q. 367, 368 (1975). However, in order show that special circumstances exist due to the interference with the business of others, the petitioner must show that (1) the business of either the petitioner or the petitioner's customer is being threatened; and (2) the petitioner's business

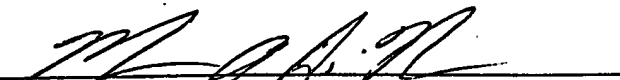
has suffered because of those threats. In re Application for Trimless Cabinets, 128 U.S.P.Q. 95, 96 (1960). Further, the notification of specific individuals that there is a patent application which may cover the product that the petitioner makes, uses, or sells is not enough of a threat to warrant a waiver of secrecy guaranteed by § 122(a) and 37 C.F.R. § 1.14. Id.

In Trimless Cabinets, the Director determined that an applicant did not threaten the business of a petitioner or the petitioner's customers. Id. In Trimless Cabinets, a petitioner alleged that an applicant interfered with its business and its customers by sending a letter that warned of possible infringement, and that therefore special circumstances existed that warranted the petitioner to be granted access to the application. Id. at 95. According to the petitioner, the letter sent by the applicant implied that the petitioner's customers will be sued for infringement and enjoined from continued use of any cabinet which infringes a patent maturing from their pending application. Id. The applicant opposed the petition for access stating that no threats or statements concerning infringement were made to any of the petitioner's customers or potential customers and that there has been no interference with the petitioner's business since only the petitioner, and not its customer, was warned of possible infringement. Id.

The Director found in Trimless Cabinets that the applicant did not threaten the petitioner's business since it merely sent a letter to a petitioner giving notice of a pending application and of the applicant's intent to enforce its rights. Id. at 96. In addition, the Director found that the applicant did not threaten the business of the petitioner's customer since there was nothing in the letter to indicate that the petitioner's customers have been threatened. As a result, the Director held that there has been no interference with the petitioner's business. Id. Accordingly, the Director denied the petitioner access to the application. Id.

In the instant case, the Applicant sent a letter to the petitioner that gave notice of a pending application, and warned of possible violations to the Applicant's rights, and of the Applicant's intent to enforce its rights. The letter was directed toward Focus Industries, and makes no mention of the Petitioner's customers. The petition does not set forth any facts that the Applicant has either stated or implied that the Applicant threatened or will threaten Petitioner's customers or potential customers with a cause of action. In addition, the Petitioner has set forth no facts that its business has suffered as a result of any threat made by the Applicant. Furthermore, the Petitioner makes no mention that the Petitioner's access to the application is necessary to carry out an Act of Congress. Thus, the Applicants respectfully submit that Petitioner has not shown that there has been interference with the business of others and therefore no special circumstances under section 1.14(j) exist to warrant Petitioner's review of the application.

Due to the reasons set forth above, the Applicant respectfully requests that the Director find, under the circumstances of the instant case, that no legal justification exists for granting the Petitioner access to the application.

By:   
Michael A. DiNardo  
Reg. No. 42487  
Attorney for Applicant

Yanny & Smith  
1925 Century Park East, Suite 1260  
Los Angeles, CA 90067  
(310) 551-2966